



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MASAHIRO KOBAYASHI, HIDEAKI MUKAIDA,  
HIROSHI MUKAIYAMA, NORIO SAWADA, MASAFUMI UEDA,  
SHIGEYA ISHIGAKI and KOJI SATO

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Application No. 09/611,562

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on April 6, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

Appellants filed an Appeal Brief on August 29, 2003 (Paper No. 19). A review of the Brief reveals that the Appendix does not include a clean copy of the claims. According to the Manual of Patent Examining Procedure (MPEP) § 1206(9) (8th ed., Rev. 1, Feb. 2003):

The copy of the claims required in the brief Appendix by 37 CFR 1.192(c)(9) should be a clean copy and should not include any markings such as brackets or underlining.

Application No. 09/611,562

Furthermore, in the latest office action mailed on April 8, 2003 (Paper No. 17), the examiner rejects claims 7 and 9 under 35 U.S.C. § 103(as) as being unpatentable over Kang in view of Park. On page 2, section (VI) of appellants' Brief (Paper No. 19), appellants clarify in their statement of the issues the rejection of claims 7 and 9 under 35 U.S.C. § 103. In addition, the examiner states on page 2, section (6) of the Answer that "appellant's [sic, appellants'] statement of the issues in the brief is correct. However, on page 4 of the Answer the examiner includes for the first time in his rejections the rejection of claim 11 under 35 U.S.C. § 103. Therefore, it appears from the record that the examiner is entering a new ground of rejection. According to MPEP § 1208(B):

A new ground of rejection is no longer permitted in an examiner's answer. . . . If a new ground of rejection is necessary, prosecution must be reopened. The examiner must obtain approval from the supervisory patent examiner prior to reopening prosecution after an appeal. See MPEP § 1002.02(d) [emphasis added].

Accordingly, it is

ORDERED that the application is returned to the examiner for resolution of the following issues:

(1) to notify appellants to provide a clean copy of the Appendix of Claims to the Brief, or for the examiner to provide a clean copy of the claims to the Brief;

Application No. 09/611,562

(2) to address the rejection of claim 11 by reopening prosecution, and to notify appellants in writing as to the proper status of claim 11 on appeal; and

(3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
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CRF/clm/lc  
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